Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES M. GRUDEN and ROBERT B. BROOKS JR.

Appeal No. 97-1147
Application 08/349,087[1]

ON BRIEF

Before FRANKFORT, McQUADE and CRAWFORD, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 4 and 7. Claims 13 through 15, the only other claims remaining in the application, stand allowed.

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[1]Application for patent filed December 2, 1994.

Claims 1 through 3, 5, 6, 8 through 12 and 16 through 18 have been canceled.

Appellants' invention is directed to a centrifugal clutch for use in a power door lock actuator. A copy of independent claims 4 and 7 on appeal may be found in the Appendix to appellants' brief.

The sole prior art reference of record relied upon by the examiner as evidence of obviousness of the claimed subject matter is:

Kagiyama et al. (Kagiyama) 4,520,914 Jun. 04, 1985

Claims 4 and 7 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kagiyama.

Reference is made to the final rejection (Paper No. 8, mailed April 22, 1996) and to the examiner's answer (Paper No. 15, mailed October 16, 1996) for the examiner's full reasoning in support of the above-noted rejection. A complete exposition of appellants' arguments thereagainst are found in the appeal

brief filed August 26, 1996 (Paper No. 13).

OPINION

After careful consideration of appellants' specification and claims, the teachings of the applied Kagiyama reference and the arguments and comments advanced by appellants and the examiner,
it is our determination that the examiner's conclusion of

obviousness regarding the claimed subject matter is unsupported by the applied prior art and will therefore not be sustained.

The Kagiyama patent discloses a centrifugal clutch arrangement for use in a power door lock actuator. Using the language of appellants' claim 4 on appeal, we note that the clutch of Kagiyama (Figs. 2-6) includes a rotatable driven member (4), a rotatable driver (5), a recess (53) in the driver, and a permanent magnet slider element (6) slidably retained in the recess and operable for selectively establishing a positive driving connection between said driver

and said driven member. A rotary drive shaft (21) of the motor (2) is inserted into the driver (5) and attached thereto. The drive shaft (21) is made of a magnetic material. As noted in column 2, lines 20-30,

> "[w]hen the clutch body is not driven the permanent magnet is moved toward the rotary drive shaft due to the magnetic attraction therebetween and is accommodated within the retaining hole. When the clutch body is being driven at a certain speed, the permanent magnet is released from the rotary drive shaft by the centrifugal force of the clutch body, projects toward the inner wall of the clutch drum and is engaged with an engaging protuberance provided in the clutch drum with the result that the rotation of the clutch body is transmitted to the clutch drum."

As the examiner has recognized (final rejection, page 4), Kagiyama does not disclose a magnetic decoupling means of the type required in appellants' claims 4 and 7 on appeal for selectively magnetically breaking the positive driving connection between the driver (5) and the driven member (4). More specifically, the clutch of Kagiyama does not include a permanent magnet "secured within said driver for magnetically attracting said slider in a direction away from said driven member, and wherein said slider is located between said

permanent magnet and said driven member," as indicated in claim 4 on appeal, and in similar language in claim 7 on appeal. To address this difference, the examiner has taken the position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the permanent magnet slider (6) of Kagiyama "a separate member from the magnet, since it has been held that constructing an integral structure into various elements involves only routine skill in the art" (final rejection, page 4). To account for the plural sliders set forth in claim 7 on appeal, the examiner urges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have plural sliders in the clutch mechanism of Kagiyama, "since it has been held that mere duplication of essential working parts of a device involves only routine skill in the art" (final rejection, page 4).

In contrast with the examiner's position, we find nothing in the Kagiyama patent which provides any teaching, suggestion or incentive which would have motivated one of ordinary skill in the art to make the particular selective modifications in

the

centrifugal clutch therein as proposed by the examiner. The mere

fact that one of ordinary skill in the art, once informed of the desirability of making a magnetic decoupling means of the type defined in appellants' claims on appeal, could achieve this result through the application of routine skill in the art, provides no evidence that such a modification would have been obvious to those of ordinary skill in the art at the time of appellants' invention, absent reliance upon appellants' own disclosure. Moreover, as appellants have pointed out on page 11 of their brief, the examiner's proposed modification of the clutch in Kagiyama would appear to be contrary to the express teachings of that patent regarding the desired simplicity of construction, reduced numbers of parts, and inexpensive manufacturing discussed therein (see Col. 1, lines 21-25 of Kagiyama).

From our perspective, only hindsight based on appellants' own teachings would have provided any reason for one of ordinary skill in the art to consider a modification in the

centrifugal clutch of Kagiyama of the nature urged by the examiner in the rejection before us on appeal so as to arrive at the clutch assembly defined in appellants' independent claims 4 and 7. This

being the case, we will not sustain the examiner's rejection of claims 4 and 7 under 35 U.S.C. § 103 based on the teachings of Kagiyama.

The examiner's reliance on and citation of Nerwin v. Erlichman, 168 USPQ 177, 179 (Bd.Pat.Int. 1969), which according to

the examiner held that "constructing a formerly integral structure in various elements involves only routine skill in the art," appears to us to be misplaced. We find no such "holding" in Nerwin v. Erlichman. The only statement in that case which we think may be referred to by the examiner is one which indicates that

> "[t]he mere fact that a given structure is integral does not preclude its consisting of various elements."

This statement, in our view, is a construction of the term "integral," and does not appear to stand for the proposition the

examiner now urges.

In light of the foregoing, we must agree with appellants' position that the examiner has failed to make out a prima facie case of obviousness under 35 U.S.C. § 103. A rejection based on §103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty

of supplying the factual basis for the rejection he advances. The examiner may not, because he (or she) doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual
basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967). Since in this case there is an inadequate factual basis to support the examiner's rejection of appellants' claims 4 and 7 under 35 U.S.C. § 103, we are compelled to reverse that rejection.

REVERSED

CHARLES E. FRANKFORT Administrative Patent Judge	)	
JOHN P. McQUADE Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
MURRIEL E. CRAWFORD Administrative Patent Judge	)	

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